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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/244.163 02/04/99 SHIOTSUKA H 35.C13307

005514 MMC1/0712  
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**EXAMINER**

HARDY, D

**ART UNIT****PAPER NUMBER**

2815

**DATE MAILED:**

07/12/00

Pl ase find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/244,163

Applicant(s)  
Shiotsuka et al.

Examiner  
David B. Hardy

Group Art Unit  
2815



☒ Responsive to communication(s) filed on Apr 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-64 is/are pending in the application.

Of the above, claim(s) 9-24, 33-48, and 57-64 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8, 25-32, and 49-56 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2815

Serial Number: 09/244163 Attorney's Docket #: 35.C13307

Filing Date: 2/4/99; earliest claimed foreign priority to 2/5/98

Applicant: Shiotsuka et al.

Examiner: David Hardy

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 25-32 and 49-56 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bohland et al. (US 6,063,995).

With respect to claims 49-56, note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, with respect to claims 8, 32 and 49-56, for example, note that a "product by process" claim is directed to the product per se, no matter how actually made and that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process.

Art Unit: 2815

Bohland et al. disclose in Fig. 2, a device comprising: a substrate (16); a filler (40); a semiconductor element (12); a protective layer (34); and an exfoliative layer (36/38), wherein the element is detachable/separable.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

**RESPONSE**


Applicant's remarks have been fully considered and completely addressed in the above Office Action.

*Papers related to this application may be submitted to Group 2800 by facsimile transmission. Papers should be faxed to Art Unit 2815 via the PTO Fax center located in Crystal Plaza 4-4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Art Unit 2815 Fax Center number is (703) 308-7722 or -7724. The Art Unit 2815 Fax Center is to be used only for papers related to Group 2800 applications.*

Any inquiry concerning this communication or any earlier communication from the examiner should be directed to **Examiner David Hardy** whose telephone number is **(703) 308-4092** and may additionally be contacted by e-mail at **david.hardy@uspto.gov**.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Group 2800 receptionist** whose telephone number is **(703) 308-0956**.

DBH  
10 July 2000

  
**DAVID HARDY**  
**PRIMARY EXAMINER**